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In re Application of LINIAL et al	:	
U.S. Application No.: 09/601,278	:	DECISION ON PETITION
Int. Application No.: PCT/IL99/00057	:	
Int. Filing Date: 29 January 1999	:	UNDER 37 CFR 1.47(a)
Priority Date: 29 January 1998	:	
Attorney Docket No.: P-1476-US	:	
For: AN AUTOMATIC METHOD OF	:	
CLASSIFYING MOLECULES	:	

This is in response to applicants' "Petition Under 37 C.F.R. 1.47(a)" filed 22 February 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

BACKGROUND

On 29 January 1999, applicants filed international application PCT/IL99/00057, which claimed priority of an earlier United States application filed 29 January 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 05 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 31 July 2000 (29 July 2000 was a Saturday).

On 31 July 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, authorization to charge the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 22 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 22 February 2001, applicants filed the present petition along with the appropriate extension of time fee. The petition states that it is accompanied by, *inter alia*: 1) a declaration signed by three of the four joint inventors and not signed by inventor Golan Yona; 2) an affidavit of Renee Ben-Israel, and 3) an authorization to charge the requisite petition fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by three of the four joint inventors on their own behalf and on behalf of the nonsigning inventor Yona.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have not demonstrated that a bona fide attempt was made to present a copy of the complete application papers (including specification, claims, drawings, and oath/declaration) to the nonsigning inventor Yona for signature. Although the affidavit of Renee Ben-Israel states that a copy of the declaration and power of attorney was sent via facsimile to Yona around 03 October 2000 (see paragraph 8 of Ben-Israel's affidavit), the affidavit

does not establish that the specification, claims, and drawings were ever presented to Yona. Ben-Israel's affidavit states, "As is evident from the e-mail dated November 2, 2000, Golan Yona reviewed the PCT Application" (see paragraph 9 of Ben-Israel's affidavit). However, applicants have not provided an affidavit of the person having firsthand knowledge of the PCT application (including specification, claims, and drawings) being presented to Yona.

Furthermore, applicants have not provided adequate proof of Yona's purported refusal to sign the application papers. Ben-Israel's affidavit states that Ben-Israel made numerous attempts to obtain Yona's signature on the declaration (see paragraph 10 of Ben-Israel's affidavit), yet fails to provide any details regarding the alleged attempts. Thus, it would be inappropriate at the present time to conclude that Yona refuses to join in the application.

With regard to item (3) above, applicants have provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

Because applicants have failed to satisfy item (2) above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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